

REMARKS

In the Office Action¹, the Examiner:

- (1) rejected claims 1, 2, 5-9, 11, 2, 15-20, 23, 24, 26, 27, and 30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0042751 to Sarno (*Sarno*);
- (2) rejected claims 10, 13, 14, 25, 28, and 29 under 35 U.S.C. § 103 as being obvious over *Sarno* in view of U.S. Patent Application Publication No. 2004/0073467 to Heyns et al. (*Heyns*); and
- (3) rejected claims 3, 4, 21, and 22 under 35 U.S.C. § 103(a) over *Sarno* in view of Official Notice.

By this Amendment, claims 31 and 32 are added. Thus, claims 1-32 are pending in this application.

1. Rejection Under 35 U.S.C. § 102

Applicant respectfully traverses the rejection of claims 1, 2, 5-9, 11, 12, 15-20, 23, 24, 26, 27, and 30 under 35 U.S.C. § 102(b) as being anticipated by *Sarno*. *Sarno* does not teach each and every element of the claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. See M.P.E.P. § 2131. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim" (emphasis added). See M.P.E.P. § 2131, quoting

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites, in part, “a cost reduction strategy tool that receives the cost levers, said strategy tool including: a generation module *that generates a cost reduction strategy for one or more of the cost levers*; a linking module that *correlates the cost reduction strategy with corresponding ones of the cost levers*; and an implementation module that *generates implementation information related to implementing the cost reduction strategy*” (emphasis added). Independent claim 16, although of different scope, recites similar elements.

The Office Action alleges that “calculating a cost reduction” in *Sarno* constitutes receiving a “cost lever.” See Office Action, pg. 4. The Office Action also alleges that *Sarno*’s disclosure of “generating a business case” teaches or suggests “generating a cost reduction strategy for one or more of the cost levers.” See *id.* Finally, the Office Action alleges that *Sarno*’s “rollout information” constitutes the claimed implementation information. See *id.* These allegations are not correct.

Sarno discloses a system and method of performing a financial analysis, such as a business case, to aid in the decision to purchase complex or expensive equipment or services. See paragraph [0110]. This business case is prepared after the business decision has been made. See *id.*; see also paragraphs [0077] and [0129]-[0141]. A business case generally the following components: (1) introduction and overview; (2) assumptions and methods; (3) business impacts; (4) sensitivity, risks, and contingencies; and (5) conclusions and recommendations. See paragraph [0129]. The “business impacts,” which is the “heart of the business case,” presents the financial

consequences of a proposed investment and related financial information. See paragraph [0137]. For example, the business case may include a bar graph representing the costs associated with not making the proposed investment. See *id.*

Sarno's system can use "rollout schedule information" to determine expenses. See paragraph [0078]. For example, a buyer of computer servers, who would incur an additional expense of one server for every 20 database administrators rolled out, could enter an expense rule dependent on database administrator rollout and allow the software to include costs associated with the additional server at the appropriate time (i.e., based on the rollout schedule of the database administrators provided by the user). Furthermore, *Sarno's* system could include a "survey generator" for "tracking the results of the implementation of a vendor product." See [0018].

First, one of ordinary skill in the art would understand that the claimed cost lever is something that affects the company's cost structure and is not simply a numerical result, such as the result of a calculated cost reduction. See, e.g., pg. 20; See *also* element 701 of Fig. 7 (showing various cost levers, such as "Reduce Training Costs").

Second, simply making a business decision and then using a business case to see if that decision is profitable does not constitute "generating a cost reduction strategy for one or more of the cost levers." Indeed, the business case may show that the business decision increases costs, rather than reduces it. Furthermore, the business case is generated without respect to any cost levers.

Third, simply entering rollout information into *Sarno's* system to determine expenses does not teach "generating implementation information related to

implementing the cost reduction strategy.” In particular, the rollout information in *Sarno* is not *related to implementing the cost reduction strategy*.

Accordingly, for at least these reasons, *Sarno* fails to teach each and every element of independent claims 1 and 16. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 1 and 16 under 35 U.S.C. § 102(b), as well as withdrawal of the rejection of dependent claims 2, 5-9, 11, 12, 15, 17-20, 23, 24, 26, 27, and 30.

2. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejections of (1) claims 10, 13, 14, 25, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Sarno* in view of *Heyns* and (2) claims 3, 4, 21, and 22 over *Sarno* in view of Official Notice.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit and stated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. § 2141. In comparing the claim to the prior art, three factual inquiries must be addressed: (1) the scope and content of the prior art must be ascertained; (2) the differences between the claimed invention and the prior art must be determined; and (3) the level of ordinary skill in the pertinent art at the time of the invention was made must be evaluated. See *id.*

Claims 3, 4, 10, 13, 14, 21, 22, 25, 28, and 29 recite each of the elements of independent claims 1 or 16. As discussed above, *Sarno* fails to teach or suggest various elements of the claims. Furthermore, *Heyns* fails to remedy the deficiencies of *Sarno* at least because *Heyns* fails to teach or suggest the claimed generation module and linking module. Moreover, assuming that the Examiner's allegations regarding Official Notice are correct, which Applicant does not concede, these allegations still fail to teach or suggest the above-recited elements of the independent claims.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 3, 4, 10, 13, 14, 21, 22, 25, 28, and 29, and Applicant respectfully requests withdrawal of the rejection of claims 3, 4, 10, 13, 14, 21, 22, 25, 28, and 29.

3. New Claims

New claims 31 and 32 are allowable over the applied art at least based on their dependence on allowable claim 1, as well as for the additional elements they recite.

4. **Conclusion**

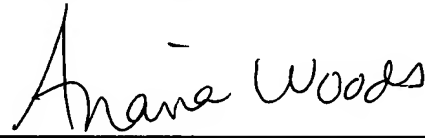
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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